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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,523	04/27/2001	George Dewey Cannon	10423-0006-999	4156
7590	12/14/2005		EXAMINER	
Kimble C. Cannon, Esq. HALE AND DORR LLP 1455 Pennsylvania Avenue, NW Washington,, DC 20004			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/844,523	CANNON ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/27/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed invention must fall into one of the four recognized statutory classes of invention, a process (or method), a machine (or system); an article of manufacture; or a composite of matter. However claim 12 does not seem to fall within one of these recognized categories. The invention seems to be directed toward an article of manufacture, however, computer program mechanism claimed as embodied in computer readable media is descriptive material per se and is not statutory because it is not capable of causing functional change in the computer. Such claimed computer programs do not define any structural and functional interrelationships between the computer code and other claimed elements of a computer, which permit the computer's program to be realized (see MPEP section 2106). Simply stated invention not claimed, as computer program that when executed by the computer causes the computer to perform the claimed limitation is not statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Slotznick (US 6011537).

Regarding claims 1 and 10, Slotznick teaches intercepting a first request (step 78) from the user for first content (primary data, step 82); determining that the second request (another primary data) is independent of said first content (step 88) (and facilitating the insertion of supplemental content (secondary information see col. 29 lines 15-43) between the first content and second content; receiving the first content; parsing the first content and determining that the second request is not embedded in the first content (see fig. 7 col. 20 line 32 to col. 21 line 64, col. 25 line 40 to col. 26 line 25, col. 29 lines 15, col. 35 line 45 to col. 36 line 67)).

Regarding claims 2-6, Slotznick teaches recognizing the second content is not related to first request (next website or next web page); or the second content is a predetermined type (HTML document); second content is not a type normally used to render first content (a web page) (see col. 20 line 32 to col. 21 line 38, col. 22 lines 47-67, col. 23 lines 1-54, col. 24 lines 11-49, col. 25 lines 8-18, col. 29 line 15 to col. 30 line 23).

Regarding claims 7-9, Slotznick teaches concluding that the second request originated from the first content and the second request is not a list of known supplemental content servers (see col. 9 line 22 to col. 10 line 5).

Claims 11 and 12 are rejected as stated above in claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

Perlman (US 6237039) teaches downloading auxiliary data to a client from a network during client idle periods.

Wolfe (US 6397246 B1) teaches, presentation of an informational, e.g., advertising, Web page before presenting the requesting client the Web page at the requested URL.

Brothers (US 6438125 B1) teaches once a predetermined criterion is met such as among others, a time period that has elapsed since the last web page request issued from the client/subscriber, a particular IP destination address requested by the client/subscriber, or the client/subscriber's IP address, substituting a replacement web page for the web page requested by the client/subscriber. Appropriate methods of returning the replacement web page to the client/subscriber include, but are not limited to, returning the replacement web page: (1) without ever returning the intended web page; (2) for only a predetermined period of time; or (3) in a secondary browser window that pops on top of the intended web page, which is returned in a primary browser window.

Servan-Schreiber (US 6892354 B1) teaches when a user clicks on a link from the currently displayed web page in order to request that a new web page be downloaded and displayed (from any particular remote server), the new http connection is established, and simultaneously, the cached advertising page, is displayed for a minimum predetermined amount of time T or until the new web page "sufficiently" is downloaded, whichever is greater.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RETTA YEHDEGA
PRIMARY EXAMINER